

## REMARKS

In accordance with the foregoing, claims 1-13 are pending and under consideration.

### CLAIM REJECTIONS UNDER 35 USC 103

Claims 1-13 are rejected under 35 USC 103(a) as being unpatentable over Tager et al. (U.S. Patent Application Publication No. 2004/0208608) in view of Ramaswami et al. (Optical Networks: A Practical Perspective, 2<sup>nd</sup> Edition).

The Office Action submits that Tager does not expressly disclose “said additional compensation amount is a predetermined constant times a total dispersion amount occurred in the divisional repeating intervals on the terminal apparatus side for transmission” as recited in claim 1 (see page 4 of the outstanding Office Action). However, a series of inferences based on visual inspection of FIG. 4 are chained in the Office Action to draw the conclusion that the recitation is not “an inventive limitation.” Applicants respectfully disagree and ask the Examiner to reconsider in view of at least the following two reasons:

1. "All words in a claim must be considered in judging the patentability of that claim against the prior art," as stated in MPEP 2143.03 (see also MPEP 2112 stating that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,” (emphasis in original), and
2. Tager actually teaches away from an embodiment having the characteristic in FIG. 4.

FIG. 4 of Tager is “a two-dimensional graph depicting accumulated dispersion versus propagation length according to an under-compensation scheme” (see [0016] therein).

Referring to FIG. 4, Tager states in paragraph [0033]:

An example of an under-compensation scheme is shown in FIG. 4, wherein dispersion is pre- and post-compensated at nodes and band-level line compensators have an absolute dispersion value smaller than that of the preceding span. **This scheme is unsuitable in that accumulated dispersion at network nodes depends on signal history, such that a region practicing this scheme is not truly switch-ready.** Such a network region could support ULH propagation, but would require a large number of wide range adjustable post-compensators at receiving nodes to accommodate switching. (Emphasis ours.)

Then, Tager proceeds in contrasting the unsuitable scheme of FIG. 4 with Tager’s invention illustrated in FIG. 5 (see paragraph [0034]). In other words, not only that Tager does not

disclose that the additional compensation amount is a predetermined constant times a total dispersion amount occurred in the divisional repeating intervals on the terminal apparatus side for transmission, but FIG. 4 of Tager, which allegedly provides implicit teachings relative to this feature (assertion that Applicants deny), is actually criticized in Tager. Tager teaches away from the teachings of FIG. 4.

Additionally, Tager does not anticipate "the ratio of the additional compensation amount at the second dispersion compensation step to the sum of the dispersion compensation amounts at the first and second dispersion compensation steps being set so as to gradually vary together with the transmission distance from said terminal apparatus for transmission at which said repeating apparatus is disposed on said light transmission line" as recited in claim 1. On lines 15-20 on page 3 of the outstanding Office Action it is stated that FIG. 4 of Tager by visual inspection and comparison with FIG. 20 in this application discloses the recited feature. Applicants disagree because the above explicitly stated manner of gradually varying the ratio of the additional compensation amount at the second dispersion compensation step to the sum of the dispersion compensation amounts at the first and second dispersion compensation steps with the transmission distance is not taught or suggested in Tager. A visual inspection and a figure comparison do not amount to teaching a positively recited feature.

Finally, claim 1 and claims 2-6 depending from claim 1 are patentable over Tager at least because Tager and Ramaswami fail to render obvious "a second dispersion compensation step of performing a dispersion compensation with an additional compensation amount [...], **said additional compensation amount is a predetermined constant times a total dispersion amount occurred in the divisional repeating intervals on the terminal apparatus side for transmission**" (emphasis ours).

Claim 7 and claims 8-12 depending from claim 7, patentably distinguish over Tager and Ramaswami at least because the prior art does not render obvious "a second dispersion compensation section performing a dispersion compensation with an additional compensation amount [...], said additional compensation amount is a predetermined constant times a total dispersion amount occurred in the divisional repeating intervals on the terminal apparatus side for transmission" as recited in claim 7.

Independent claim 13 patentably distinguishes over the cited prior art at least by reciting "performing a second dispersion compensation using a dispersion compensation having an additional compensation amount [...] wherein said additional compensation amount is a predetermined constant times a total dispersion amount occurred in the divisional repeating

intervals on the terminal apparatus side for transmission."

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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